

### **Remarks/Arguments**

The foregoing amendments to the claims are of formal nature, and do not add new matter. Claims 119-123 and 139-142 have been canceled without prejudice or disclaimer. Claims 135 and 143 have been amended to correct claim dependency. Accordingly, Claims 124-127, 129-131, 135-138 and 143 are currently pending in this application and rejections to these claims are respectfully traversed.

#### **Claim Rejections – 35 U.S.C. § 101 and 35 U.S.C. § 112, first paragraph**

Claims 119-123 and 135-138 are rejected under 35 U.S.C. §101 for lack of utility.

Claims 119-123 and 135-138 are further rejected under 35 U.S.C. §112, first paragraph since one skilled in the art would not know how to use the claimed invention.

In view of the cancellation of claims 119-123 and further in view of the change in dependency of claims 135-138 onto allowable claim 124, and further onto claim 143, whose utility is based on the “chondrocyte redifferentiation” assay, Applicants believe that this rejection is moot and accordingly, these rejections under 35 U.S.C. §101 and under 35 U.S.C. §112, first paragraph should be withdrawn.

#### **Claim Rejections – 35 U.S.C. § 112, second paragraph**

Claims 119-123 and 135-143 are rejected under 35 U.S.C. §112, second paragraph for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

As discussed above, in view of the cancellation of claims 119-123 and further, in view of the change in dependency of claims 135-138 onto claim 143, rejections to these claims are moot. Further, part (c) of claim 43 has been amended for clarity. Therefore, Applicants believe that this rejection should be withdrawn.

#### **Claim Rejections – 35 USC § 102**

22. Claims 119-122 and 135-142 are rejected under 35 U.S.C. §102(a) as being anticipated by Jacobs (WO 98/32853, dated July 30, 1998).

In view of the cancellation of claims 119-122 and 139-142 without prejudice or disclaimer, the rejection to these claims are moot. Further, claim 135 has been amended to depend upon allowable claim 124 and amended claim 143. The Examiner acknowledged that the Applicants are entitled to the priority date of **August 18, 1998** for this application but finds the declaration filed under 37 C.F.R. §1.131 defective because it was not signed by all the inventors of the rejected claims.

Applicants submit that due to amendments made to the claims during prosecution, the inventorship for the instant application has changed. Applicants filed an amendment for correction of the inventorship for this case on April 18, 2005 under 37 C.F.R. §1.48(b). Further, Applicants hereby file a newly executed declaration reflecting all the current inventors of the invention under 37 C.F.R. §1.131, namely, Luc Desnoyers, Audrey Goddard, Paul Godowski, Austin Gurney and William Wood. Applicants believe that this declaration should be sufficient to obviate the instant rejection anticipated by Jacobs since Applicants had cloned and sequenced the nucleic acid on **May 29, 1998**, thereby predating the Jacobs reference. Accordingly, claims 139-142 are not anticipated by Jacobs *et al.* and therefore, this rejection should be withdrawn.

*A copy of the executed declaration by Austin Gurney will be filed shortly.*

23-24. Claims 135-142 are rejected under 35 U.S.C. §102(e) as being anticipated by Edwards (USPN 6,312,922, priority date 2/9/1998 and USPN 6,222,029, filed 8/1/1997).

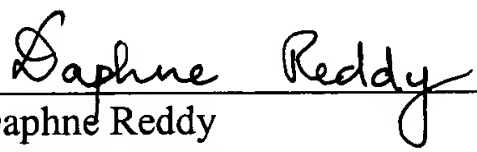
In view of the amendment to claim 135-138 to depend directly or indirectly upon allowable claim 124 and amended claim 143, and due to the cancellation of claims 139-142, these rejections are moot and should be withdrawn.

The present application is believed to be in *prima facie* condition for allowance, and an early action to that effect is respectfully solicited.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 08-1641 (Attorney Docket No.: 39780-2730P1C67). Please direct any calls in connection with this application to the undersigned at the number provided below.

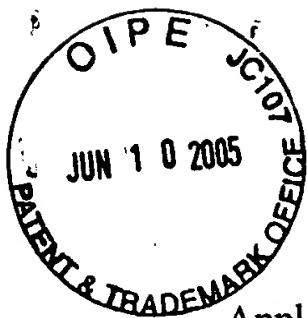
Respectfully submitted,

Date: June 10, 2005

  
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Desnoyers et al. Docket No: 39780-2730P1C39 and  
39780-2730P1C67  
Serial No: 09/997641 & 09/989724 Group Art Unit: 1647  
Filed: Examiner: David Blanchard  
For: **SECRETED AND TRANSMEMBRANE POLYPEPTIDES AND NUCLEIC  
ACIDS ENCODING THE SAME**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

**DECLARATION OF LUC DESNOYERS, Ph.D.,**  
**AUDREY GODDARD, Ph.D., PAUL J. GODOWSKI, Ph.D.,**  
**AUSTIN GURNEY, Ph.D., and WILLIAM I. WOOD, Ph.D. UNDER 37 C.F.R. §1.131**

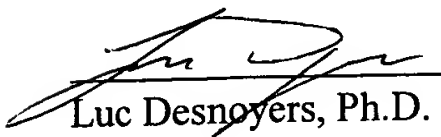
We, Luc Desnoyers, Ph.D., Audrey Goddard, Ph.D., Paul J. Godowski, Ph.D., Austin Gurney, Ph.D., and William I. Wood, Ph.D. declare and say as follows:

1. We are the inventors of the above-identified application.
2. We have read and understood the claims pending in this application, and are aware that the claims have been rejected as anticipated by the PCT Patent Publication WO 98/32853 (Jacobs *et al.*, dated July 30, 1998).
3. The polypeptide designated as PRO1312 (SEQ ID NO:387) claimed in the above-identified application in the United States was sequenced and cloned prior to July 30, 1998.
4. At the time the PRO1312 polypeptide was cloned and sequenced, one of the inventors, Austin Gurney, Ph.D., was responsible for overseeing the cloning of cDNAs which encoded novel polypeptides, including the cDNA that encoded PRO1312 polypeptide (SEQ ID NO:387) claimed in the above-identified application.
5. At the time the PRO1312 polypeptide was cloned and sequenced, one of the inventors, Audrey Goddard, Ph.D., was responsible for overseeing the sequencing of cDNAs

encoding for novel polypeptides, including the PRO1312 polypeptide (SEQ ID NO:387) claimed in the above-identified application.

6. A cDNA clone, referred to as DNA61873-1574 in the above-identified application, was identified as encoding the PRO1312 polypeptide.
7. The full length of the cDNA clone is shown in Figure 277 of the above-identified application. The full length of the PRO1312 peptide encoded by DNA61873-1574 is shown in Figure 278 of the above-identified application. The full-length PRO1312 polypeptide has 212 amino acid residues.
8. Copies of the pages from the GSeqEdit database which report the cloning and sequencing data for the PRO1312 polypeptide sequence and its encoding nucleic acid sequence are attached to this declaration (with the dates redacted) as Exhibit A.
9. The GSeqEdit report shows the full-length nucleic acid sequence for DNA61873-1574 (identified as "DNA-61873") and the full-length PRO1312 polypeptide encoded by DNA-61873. Both the DNA-61873 and the PRO1312 polypeptide sequences were obtained prior to July 30, 1998.
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12. The amino acid sequence shown in the GSeqEdit report is identical to that of SEQ ID NO: 387 disclosed in the above-identified application.
13. The first 4 amino acid residues of the PRO1312 polypeptide (SEQ ID NO:387) encoded by the cDNA (DNA-61873) are also shown on page 1 of the GSeqEdit report and the remaining 208 residues appear on pages 2-4 of the report.

14. All activities listed under paragraphs 4-13 were completed prior to July 30, 1998.  
(See Exhibit A).
15. We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information or belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful statements may jeopardize the validity of the application or any patent issued thereon.

  
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04/20/2005  
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Date

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Audrey Goddard, Ph.D.

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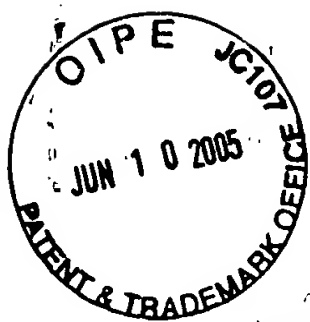
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William I. Wood, Ph.D.

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Audrey Goddard, Ph.D.

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